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amended claims.

#### REMARKS

Claims 1 to 52 were pending in the subject application. By this Amendment, applicants have canceled claims 1 to 12, 24, 26, 32 to 40, 43, 44, and 46 to 52 without prejudice or disclaimer and amended claims 20, 28, 41 and 45. Accordingly, upon entry of this Amendment, claims 13 to 23, 25, 27 to 31, 41, 42 and 45 as amended will be pending and under examination.

By this Amendment, applicants have amended the specification to update the continuing data and amended claims 20, 28, 41 and 45. Support for claim 20 may be found inter alia in the specification, as originally-filed, at page 59, line 35 through page 60, line 1. Support for claim 28 may be found inter alia in the specification, as originally-filed, at page 60, lines 26 to 31. Support for claim 41 may be found inter alia in the specification, as originally-filed, at page 62, lines 1 to 6. Support for claim 45 may be found inter alia in the specification, as originally-filed, at page 62, lines 18 to 22. Accordingly, applicants maintain that this amendment raises no issue of new matter and respectfully requests that this amendment be entered.

#### Information Disclosure Statement

In accordance with the duty of disclosure under 37 C.F.R. §1.56 and §1.97 (a)-(b), applicants would like to direct the Examiner's attention to the following references which are listed on the attached Form PTO-1449 (**Exhibit 2**). The following references were

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previously cited in connection with the prosecution of U.S. Serial Number 08/858,017 from which the subject application claims benefit under 35 U.S.C. §120. According to 37 C.F.R. §1.98(d), copies of patents or publications that were previously cited by, or submitted to, the Office in connection with such prior applications need not accompany the Information Disclosure Statement. Accordingly, copies of the following references are not attached to this Information Disclosure Statement:

1. U.S. Patent No. 4,438,117, issued March 20, 1984, Cherkofsky;
2. U.S. Patent No. 4,684,653 issued August 4, 1987 Taylor et al.;
3. U.S. Patent No. 4,684,655 issued August 4, 1987 Atwal et al.;
4. U.S. Patent No. 4,684,656, issued August 4, 1987, Atwal, et al.;
5. U.S. Patent No. 4,703,120, issued October 27, 1987, Press, J.B.;
6. U.S. Patent No. 4,728,652 issued March 1, 1988, Atwal;
7. U.S. Patent No. 4,845,216 issued July 4, 1989, Taylor et al.;
8. U.S. Patent No. 4,855,301 issued August 8, 1989, Atwal et al.;
9. U.S. Patent No. 4,882,334 issued November 21 1989, Shih et al.;

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10. U.S. Patent No. 4,902,796 issued February 20, 1990 Taylor et al.;
11. U.S. Patent No. 4,946,846 issued August 9, 1990 Nomura et al.;
12. U.S. Patent No. 5,134,145 issued July 28, 1992, Brouwer et al.;
13. U.S. Patent No. 5,149,810, issued September 22, 1992, Perrior, et al.;
14. U.S. Patent No. 5,202,330 issued April 13, 1993, Atwal et al.;
15. U.S. Patent No. 5,250,531, issued October 5, 1993, Cooper;
16. U.S. Patent No. 5,292,740, issued March 8, 1994, Burri et al.;
17. U.S. Patent No. 5,521,189, issued May 28, 1996, Boykin et al.;
18. U.S. Patent No. 5,541,186, issued July 30, 1996, Breu et al.;
19. U.S. Patent No. 5,500,424, issued 3/19/1996, Nagamine et al.;
20. U.S. Patent No. 5,594, 141, issued January 14, 1997, Yuan et al.;
21. U.S. Patent No. 5,942,517, issued August 24, 1999, Nagaratham et al.;
22. PCT International Application No. WO 99/48530 published

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September 30, 1999;

23. PCT International Application No. WO 99/07695 published February 18, 1999;
24. PCT International Application No. WO 98/51311 published November 19, 1998;
25. PCT International Application No. WO 97/42956 November 20, 1997;
26. PCT International Application No. WO 94/22829 published October 13, 1994;
27. PCT International Application No. WO 94/10989, published May 26, 1994;
28. PCT International Application No. WO 92/14453 September 3, 1992;;
29. PCT International Application No. WO 92/00741, published January 23, 1992;
30. European Patent Application No. EP 0 627 427, published December 7, 1994;
31. European Patent Application No. EP 0 622 369, published November 2, 1994;
32. European Patent Application No. EP 0 622 366, published November 2, 1994;

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33. European Patent Application No. EP O 459 666, December 4, 1991;
34. European Patent Application No. EP O 400 665, published December 5, 1990;
35. European Patent Application No. EP O 280 227, published August 31, 1988;
36. European Patent Application No. EP O 237,347, September 16, 1987;
37. European Patent Application No. EP O 236 902, published September 16, 1987;
38. European Patent Application No. EP O 234 830, published September 2, 1987;
39. European Patent Application No. EP O 204 317, December 10, 1986;
40. European Patent Application No. EP O 162 208, published November 27, 1985;
41. French Patent Application No. 2 610 625 A, published August 12, 1988;
42. Japanese Patent no 56.59778 5/23/81;

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43. Japanese KOKAI 62-265271 11/18/87;
44. Japanese KOKAI 62-87574 4/22/87:
45. Japanese KOKAI 61-282367 12/12/86;
46. Atwal, K.S. et al., "Dihydropyrimidine Calcium Channel Blockers. 2. 3-Substituted-4-aryl-1,4-dihydro-6-methyl-5-pyrimidinecarboxylic Acid Esters as Potent Mimics of Dihydropyridines," Journal of Medicinal Chemistry (1990), 33(9): 2629-2635;
47. Atwal, K.S. et al., "Dihydropyrimidine Calcium Channel Blockers. 3. 3-Carbamoyl -4-aryl-1,2,3,4-tetrahydro-6-methyl-5-pyrimidinecarboxylic Acid Esters as Orally Effective Antihypertensive Agents," Journal of Medicinal Chemistry (1991) 34(2): 806-811;
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50. Atwal, K.S. et al., "Synthesis of Substituted 1, 2, 3, 4-Tetrahydro-6-Methyl-2-Thioxo-50Pyrimidinecarboxylic Acid

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58. Khanina, E.L. et al., Alkylation of derivatives of 2-oxo-4-phenyl-6-methyl-1,2,3,4-tetrahydropyrimidine-5-carboxylic acid. Chemical Abstracts 89: 43319 (1978);
59. Mamaev, V.P. and Dubovenko, Z.D., Pyrimidines. XXI. 5-Substituted 2-hydroxy-4,6-diphenylpyrimidines. Chemical Abstracts 73: 77187 (1970);
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61. Rovnyak, G.C. et al., "Dihydropyrimidine Calcium Channel Blockers. 4. Basic 3-Substituted-4-aryl-1,4-dihydropyrimidine-5-carboxylic Acid Esters," Journal of Medicinal Chemistry (1992) 35(17): 3254-3263;
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64. Wetzel, J.M., et al., "Discovery of 1 $\alpha$ -Adrenergic Receptor Antagonists Based on the L-Type  $Ca^{2+}$  Channel Antagonist Niguldipine" Journal of Medicinal Chemistry (1995) 38(10):

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1579-1581; and

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If a telephone conference would be of assistance in advancing the prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone the number provided below.

No fee, other than the enclosed \$355.00 filing fee, is deemed necessary in connection with the filing of this Amendment and Information Disclosure Statement. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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Marked-up Version Of Amended Claims

Additions to the text are indicated by underlining; deletions are indicated by square brackets.

In the Claims

- 20. (Amended) A pharmaceutical composition comprising a therapeutically effective amount of the compound of claim [1] 13 and a pharmaceutically acceptable carrier.--
- 28. (Amended) A method of treating a subject suffering from benign prostatic hyperplasia which comprises administering to the subject an amount of the compound of claim [1] 13 effective to treat benign prostatic hyperplasia.--
- 41. (Amended) A method of treating a subject suffering from benign prostatic hyperplasia which comprises administering to the subject an amount of the compound of claim [1] 13 in combination with a 5 alpha-reductase inhibitor effective to treat benign prostatic hyperplasia.--
- 45. (Amended) A pharmaceutical composition comprising a therapeutically effective amount of the compound of claim [1] 13 in combination with a therapeutically effective amount of finasteride and a pharmaceutically acceptable carrier.--